

## EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1	("20050140030").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2006/09/28 11:00
L2	1	("6805808").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2006/09/28 11:19
L3	1	("6198630").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2006/09/28 11:19
S1	1	("20020110335").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2006/09/27 10:53
S2	66	(@ad<"20030702") and (257/726, 727.ccls and 257/706,707,704.ccls.)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 10:54
S3	24	S2 and (standoff or spacer or pillar or column or support)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:19
S4	13	S3 and (solder or ball\$1 or bump\$1)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:14
S5	29	S2 and (shim or ring or standoff or spacer or pillar or column or support)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:13
S6	16	S5 and (solder or ball\$1 or bump\$1)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:21
S7	3	S6 not S4	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:14

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S8	589	(@ad<"20030702") and (standoff or spacer or pillar or column or support)and 257/718,719.ccls.	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:27
S9	274	S8 and (solder or ball\$1 or bump\$1)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:27
S10	687	(@ad<"20030702") and (shim or ring or stiffner or standoff or spacer or pillar or column or support) and 257/718,719.ccls.	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 11:27
S11	321	S10 and (solder or ball\$1 or bump\$1)	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT; IBM_TDB	OR	OFF	2006/09/27 14:04
S12	1	("5891761").PN.	USPAT; USOCR	OR	OFF	2006/09/27 14:04
S13	4	("3904262"   "5313099"   "5883783"   "6297961").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2006/09/27 15:35
S14	0	("6618251").URPN.	USPAT	OR	OFF	2006/09/27 15:35
S15	0	("6618251").URPN.	USPAT	OR	OFF	2006/09/27 15:35
S16	0	("6618251").URPN.	USPAT	OR	OFF	2006/09/28 10:50

the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in *Donaldson*, the Federal Circuit stated:

Per our holding, the “broadest reasonable interpretation” that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

## I. LANGUAGE FALLING WITHIN 35 U.S.C. 112, SIXTH PARAGRAPH

The USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that 35 U.S.C. 112, sixth paragraph “merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation.”). The Federal Circuit has held that applicants (and reexamination patentees) before the USPTO have the opportunity and the obligation to define their inventions precisely during proceedings before the PTO. See *In re Morris*, 127 F.3d 1048, 1056–57, 44 USPQ2d 1023, 1029–30 (Fed. Cir. 1997) (35 U.S.C. 112, second paragraph places the burden of precise claim drafting on the applicant); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the PTO); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (patentee who had a clear opportunity to negotiate broader claims during prosecution but did not do so, may not seek to expand the claims through the doctrine of equivalents, for it is the patentee, not the public, who must bear the cost of failure to seek protection for this foreseeable alteration of its claimed structure). Applicants and reexamination patentees before the USPTO have an opportunity and obligation to specify, consistent with these guidelines, when a claim limitation invokes 35 U.S.C. 112, sixth paragraph.

A claim limitation will be ~~>presumed<~~ to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for” or “step for;”
- (B) the “means for” or “step for” must be modified by functional language; and
- (C) ~~the phrase “means for” or “step for” must not be modified by sufficient structure, material, & or acts for achieving the specified function.~~

With respect to the first prong of this analysis, a claim element that does not include the phrase “means for” or “step for” will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines; or (B) show that even though the phrase “means for” or “step for” is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000) (Claim limitations were held not to invoke 35 U.S.C. 112, sixth paragraph, because the absence of the term “means” raised the presumption that the limitations were not in means-plus-function form~~>~~and the applicant did not rebut that presumption~~<.~~); see also *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002) (“[W]here a method claim does not contain the term step[s] for,’ a limitation of that claim cannot be construed as a step-plus-function limitation without a showing that the limitation

